

### REMARKS

Claims 4, 6, 17 and 18 have been amended. The claims have been rewritten to place them in better form for examination and to further obviate the 35 U.S.C. §§102, 103 and 112 rejections set forth in the Office Action dated July 5, 2001. It is believed that none of these amendments constitute new matter. Withdrawal of these rejections is requested.

Claims 1-22 are rejected under 35 U.S.C. §112, first paragraph. Applicant submits the words "uncharacterized DNA" as used in the specification and claims has a standard recognized meaning by skilled artisans. Applicants have sufficiently described the method of the present invention and are clearly in possession of the claimed invention.

The Wilson Declaration clearly shows unsequenced DNA fragments which are uncharacterized. The Wilson Declaration further provides standard procedures used by skilled artisans. The Stine Declaration states no undue experimentation is required to screen plants since these screening procedures are standard and conventionally done by plant breeders. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-22 remain rejected under 35 U.S.C. §112, first paragraph for enablement. Applicant submits the purpose of the Stine Declaration is to describe what is routine in plant breeding including selection for agronomic traits. The Stine Declaration states no undue experimentation is required to screen plants since the screening procedures are standardly done by plant breeders. The present invention involves selecting whole plants and not selecting genes. The Wilson Declaration clearly shows unsequenced DNA fragments which are uncharacterized. The Wilson Declaration further provides standard procedures used by skilled artisans. In the Wilson Declaration the "piece of unsequenced DNA" represents this uncharacterized DNA and represents any uncharacterized DNA. Applicants have fully enabled the method of the present invention for any uncharacterized DNA. There is nothing unique with any other uncharacterized DNA and their use in the methods of the present invention.

Applicant submits the uncharacterized DNA fragment will either have, or not have, one or more regulatory DNA fragment. If no regulatory fragment is present, then plants having improved agronomic characteristics will not be obtained. Withdrawal of this rejection is respectfully requested.

Claims 1-4, 6 and 15-18 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicant submits that "uncharacterized" is the same standard meaning as recognized by skilled artisans. Applicant further submits that "improved agronomic characteristics" are identified in the specification on page 6, line 12 through 16, and include resistance to drought and heat stress, resistance to insects, resistance to bacterial and fungal pests, increased vigor, increased standability, superior combinability and superior yield. A skilled artisan would know to compare the plant derived from the method of the present invention versus the original recipient plant. Withdrawal of this rejection is respectfully requested.

Claims 4-6 are rejected under 35 U.S.C. §112, second paragraph as being vague. Applicant has amended claims 4 and 6 for clarification purposes. Withdrawal of this rejection is respectfully requested.

Claims 17 and 18 are rejected under 35 U.S.C. §112, second paragraph as being vague. Applicant has amended claims 17 and 18 for clarification purposes. Withdrawal of this rejection is respectfully requested.

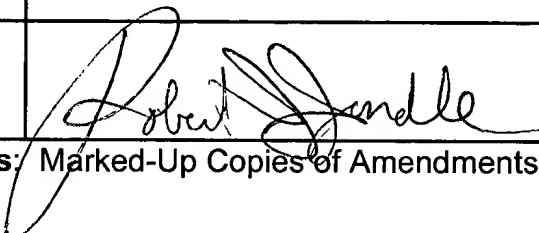
Claims 1, 2, 8 and 9 remain rejected under 35 U.S.C. §102(b) as being clearly anticipated by Masoud et al. Applicant submits Masoud et al. describes the transformation of a plant with a construct which comprises the CaMV 35S promoter, cDNA encoding cysteine proteinase inhibitor and NOS 3' region. This construct is fully characterized. Thus, Masoud et al. teaches the transformation of plants with characterized DNA. The Examiner asserts that the DNA taught by the reference has not been fully "characterized" to show the intron and other regulatory regions for example. However, the DNA of the reference is a cDNA encoding cysteine proteinase inhibitor. There does not appear to be any disclosure in the reference concerning the genomic structure of the gene. Whether the genomic structure of this gene is known is

not relevant since the DNA used to transform the plants is fully characterized as noted above. There is no disclosure in Masoud of using genomic DNA for a cysteine proteinase inhibitor to transform plants. Thus, Masoud utilizes a fully characterized DNA for plant transformation. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-22 remain rejected under 35 U.S.C. §103 as being unpatentable over Masoud et al. in view of Hamilton et al. Applicant submits Masoud et al. describes the transformation of a plant with a construct which comprises the CaMV 35S promoter, cDNA encoding cysteine proteinase inhibitor and NOS 3' region. This construct is fully characterized. Thus, Masoud teaches the transformation of plants with characterized DNA. The Examiner states that it would be obvious to modify Masoud et al. to use the BIBAC vector of Hamilton et al. Even if this modification was made, the DNA used by Masoud et al. to transform a plant is a fully characterized DNA as noted above. Furthermore, there is no motivation to combine these references since one is directed to a specific DNA construct of a size which is readily transferred to plants without the use of a vector made for handling large fragments of DNA. Accordingly, withdrawal of this rejection is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

In view of the above amendments and remarks, it is submitted that the claims satisfy the provisions of 35 U.S.C. §§ 102, 103 and 112 and are not obvious over the prior art. Reconsideration of this application and early notice of allowance is requested.

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT REQUIRED			
NAME AND REG. NUMBER	Robert J. Jondle, Reg. No. 33,915		
SIGNATURE		DATE	January 7, 2002

**Attachments:** Marked-Up Copies of Amendments



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JAN 16 2002

Serial No. 09/140,886

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Mark-ups, Page 1

**Amended Claims: Version with markings to show changes made**

Please amend claims 4, 6, 17 and 18.

4. (AMENDED) The method of claim 1, ~~wherein seed is harvested from regenerated plants which have been selfed~~ which further comprises selfing said selected plants and harvesting resultant seed.

6. (AMENDED) The method of claim 1, ~~wherein said~~ which further comprises introducing said selected plants having an improved agronomic characteristic are ~~introduced~~ into a breeding program to produce progeny of said plants, said progeny maintaining said improved agronomic characteristic.

17. (AMENDED) The method of claim 15, ~~wherein seed is harvested from regenerated plants which have been selfed~~ which further comprises selfing said selected plants after step (I) and harvesting resultant seed.

18. (AMENDED) The method of claim 15, ~~wherein seed is harvested from regenerated plants which have been backcrossed to the recipient plant species~~ which further comprises backcrossing recipient plant species to said selected plants after step (I) and harvesting resultant seed.